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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/980,839 | 06/21/2002 | Marie Flamand | 03495.0213 | 3749 |

22852 7590 11/20/2003

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EXAMINER

STUCKER, JEFFREY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1648

DATE MAILED: 11/20/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,839

Applicant(s)

FLAMAND ET AL.

Examiner

Jeffrey Stucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-42 is/are pending in the application.
- 4a) Of the above claim(s) 21-26,31,37,39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30, 41, and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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This Office Action is in response to the amendment filed 9/26/03. Claims 21-26, 31-37, 39, and 40 are withdrawn from consideration as being drawn to non-elected inventions and claims 27-30, 38, 41, and 42 are under final rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

The rejection of claims 27-30 and new claim 42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained**.

Claims 27-30 and 42 are indefinite because it is not clear what distinguishes the capture antibody from the revelation antibody as they are each described the same way. The amendment to the claims still does not distinguish between the first and second antibody because 1) "identifiable with a conjugated label" does not describe the antibody itself, 2) could apply to virtually any antibody, and 3) there is no requirement that the antibodies be different, as acknowledged by applicant on page 8 of the arguments.

The rejection of claims 27-30 and 38 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** in view of the amendment to the claim.

The rejection of claims 27-30 under 35 U.S.C. § 103(a) as obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. (J. of Gen. Vir., 1994) **is maintained**.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The instant invention is obvious over the admissions in the specification in view of both Zuk et al. and Crooks et al.

The rejection of claim 38 under 35 U.S.C. § 103(a) as obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. (J. of Gen. Vir., 1994) further in view of Harlow et al. **is maintained**.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking

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references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The instant invention is obvious over the admissions in the specification in view of both Zuk et al. and Crooks et al. further in view of Harlow et al.

The following are new grounds of rejection necessitated by applicant's amendment.

Claim 27 and new claim 41 are rejected under 35 U.S.C. § 103(a) as obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. (J. of Gen. Vir., 1994) further in view of Harlow et al.

Claim 41 specifies that the revelation antibody is labeled.

The relevance of the specification in view of both Zuk et al. and Crooks et al. has been previously set forth. See previous Office Action.

Harlow et al. teaches that the second antibody, equivalent to the instant "revelation antibody", is labeled. There, the instant invention is obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. and further in view of Harlow et al.

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Claim 27 and new claim 42 are rejected under 35 U.S.C.

§ 103(a) as obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. (J. of Gen. Vir., 1994) further in view of Tijssen.

Claim 42 specifies that a labeled third antibody be included.

The relevance of the specification in view of both Zuk et al. and Crooks et al. has been previously set forth. See previous Office Action.

Tijssen teaches that labeled third antibody can be used in immunoassays. See figure 2.2d and the accompanying text. Therefore, the instant invention is obvious over the admissions in the specification in view of both Zuk et al. (US 4281061) and Crooks et al. further in view of Tijssen.

No claims are allowed.

Applicant's amendment necessitated the new grounds of rejection. Therefore, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD

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WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

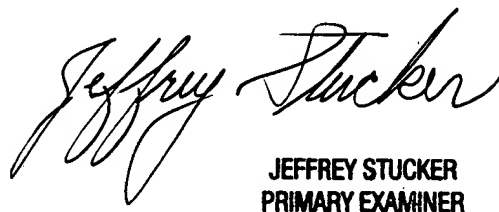
Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Official Fax number is: (703) 728-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (703) 308-4237. The examiner can normally be reached Monday to Thursday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center Customer Service Representative whose telephone number is (703) 308-0198.


JEFFREY STUCKER
PRIMARY EXAMINER